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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,254	11/20/2003	Lionel M. Nelson	9473.18472	8150

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EXAMINER

LEWIS, KIANDRA CHARLE

ART UNIT PAPER NUMBER

3743

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,254

Applicant(s)

NELSON ET AL.

Examiner

Kiandra C. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:
 - a. Species 1 - an apparatus for implantation into tissue within a pharyngeal wall to fixate to at least one vertebra Claims 1,3-18,20-27,28,30-46, Fig. 14, Fig 20, Fig. 24
 - b. Species 2 - an apparatus for implantation in tissue within a tongue, and/or vallecula to fixate or brace tissue along a pharyngeal conduit Claims 2-16,19,24-27,29,30-45, Fig. 2, Fig. 10, Fig. 11, Fig. 16, Fig. 17, Fig. 18, Fig. 19, Fig. 22
2. If the applicant elects species 2, a further election must be made in regards to claim 2. The applicant must elect: a tongue, a velleculla, or a tongue and vallecula. The applicant must then elect whether the apparatus will: fixate, brace, or fixate and brace. As to claim 19 of the species the applicant must elect between adhesive, cement, or adhesive and cement.
3. If the applicant elects species 1, an election must be made in regards to claims 18, 20-23. As to claim 18 the applicant must elect adhesive, cement, or adhesive and cement. The applicant claims that the structure includes a material that braces tissue in the pharyngeal wall against collapse (claim 20) and the structure includes a material that fixates tissue in the pharyngeal wall against collapse (claim 21). Continually the applicant claims the structure braces tissue in the pharyngeal wall against collapse

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(claim 22) and the structure fixates tissue in the pharyngeal wall against collapse (claim 23). An election must be made of **one** claim from each of the following groups:

- c. Group 1 – claim 20 or claim 21
 - d. Group 2 – claim 22 or claim 23
4. Regarding **Either** Species the following election must be made:
5. In regards to claim 3 the applicant must elect a plastic, a metal, a fabric, a ceramic, plastic and metal, plastic and fabric, plastic and ceramic, metal and fabric, metal and ceramic, fabric and ceramic, or a combination.
6. The applicant claims patentably distinct sub-species. In regards to the material the structure is comprised of the applicant must elect between claims 4(structure comprises a static material) and claim 5(structure comprises a dynamic material).
- e. Subspecies 1, a static material, claim 4,6,30-32
 - f. Subspecies 2, a dynamic material, claim 5, (7 or 8), 33-37,38-41,
 - i. Claim 7 – spring like mechanical property
 - ii. Claim 8 – elastic mechanical property

In the event that the applicant elects subspecies 2 the applicant must elect a spring-like mechanical property or an elastic mechanical property. Upon election of subspecies 1 the applicant must

7. In regards to claims 9-12 the applicant must elect either a structure that includes at least one ferromagnetic material (claim 9), a shape memory material (claim 10), a shape (claim 11), or a thermal shape memory material (claim 12).

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8. In regards to claim 14, the applicant must elect a magnetic field, a temperature condition, electrical energy, electromagnetic energy or a combination.

9. In regards to claims 30-32, the applicant must elect pharyngeal structures, individual anatomic components or pharyngeal structures and individual anatomic components.

10. In regards to claims 33-37 the applicant must elect pharyngeal structures, individual anatomic components, or pharyngeal structures and anatomic components. As to claim 36 the applicant must elect plastic, metal, fabric, ceramic, or combination.

11. In regards to claims 38-41, the applicant must make a further election. As to 38 and 41 the applicant must elect brace or fixate; pharyngeal structures, individual anatomic components, or pharyngeal structures and individual anatomic components. As to claim 40 the applicant must elect plastic, metal, fabric, ceramic, or a combination.

12. In regards to claim 42-45 the applicant must elect brace or fixate; and pharyngeal structures, individual anatomic component, or pharyngeal and anatomic components

13. The species are independent or distinct because they are disclosed as clear alternatives in function and in use more specifically there is no disclosed relationship between the species and they are unconnected in design and operation.

Conclusion

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

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distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiandra C. Lewis whose telephone number is 571-272-7517. The examiner can normally be reached on Mon-Thurs 9AM-6PM and alternating Fridays 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCL



Henry Bennett
Supervisory Patent Examiner
Group 3700